

### **REMARKS**

This responds to the Office Action mailed on December 31, 2007.

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-47 are now pending in this application.

#### **§103 Rejection of the Claims**

Claims 1, 3-10, 12-14, 17-20, 22-25, 27-28, 31-40, 42, 44-45 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser (U.S. 5,664,115) in view of Tozzoli et al. (U.S. 5,717,989; hereinafter "Tozzoli").

In rejecting claims under 35 U.S.C. §103, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See M.P.E.P. §2142.

In the recent decision of the Supreme Court on *KSR Int'l Co. v. Teleflex Inc.*<sup>1</sup>, the analysis of obviousness previously set forth in *Graham v. John Deere Co. of Kansas City*<sup>2</sup>, was reaffirmed. The Court in *Graham* set out an objective analysis for applying §103 as follows:

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined."<sup>3</sup>

When claim elements are found in more than one prior art reference, the fact finder must determine "whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims." *In re Kahn*<sup>4</sup>. In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co. of Kansas City*<sup>5</sup>.

---

<sup>1</sup> 127 S.Ct. 1727, 82 USPQ.2d 1385 (2007).

<sup>2</sup> 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

<sup>3</sup> The Court in *KSR v. Teleflex*, at page 1730, quoted the analysis of *Graham* from page 18.

<sup>4</sup> 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

<sup>5</sup> 383 U.S. 1 at 467.

Further, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*<sup>6</sup>. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*<sup>7</sup>. Office personnel must rely on the applicant's disclosure to properly determine the meaning of the claims. *Markman v. Westview Instruments*<sup>8</sup>. The Examiner asserts that the "Fraser system passes the buyer's transaction request (or buyer criteria) made by buyers to sellers after evaluating the buyer's ability to purchase the desired property []." However, neither the transaction request nor the buyer criteria is provided to the buyer in Fraser. See Col 6 line 40 - Col 7 line 10.

In Fraser, a buyer can input buyer criteria to receive property listings that meet the buyer's criteria. See Col 6 lines 49-52. If a buyer requests from the system more information on a seller, "the system then requests information about the prospective buyer, such as name, address, telephone number, available cash, or business experience, as well as [identification of the selected properties] for which additional information is requested." See Col 6 lines 51-58 (emphasis added) and See Col 10 lines 5-8. The system then executes an evaluation program to determine whether the prospective buyer matches minimum criteria for purchasing selected property items. See Col 6 lines 59-63. "The results of [the] evaluation [are] then recorded along with the other information provided by the prospective buyer and passed along directly to the seller []." See Col 7 lines 1-3 (emphasis added). The other information provided by the prospective buyer is buyer information and not a transaction request. See Col 3 lines 37-40, Col 5 lines 9-12, and Col 7 lines 3-8. Thus, Fraser contains no teaching or suggestion to provide the transaction request from the transaction center to a subset of the plurality of responsible parties having a matched property profile as stated in the claims. In fact, the Examiner states as much on page 5, lines 12-13 of the Office Action.

The Examiner has further asserted that "[i]t would have been obvious for an artisan at the time [of] the invention to modify the matching system of Fraser to provide the transaction request to the responsible parties as disclosed in the matching system of Tozzoli to allow sellers to accept, reject and/or change criteria so as to further matching and/or negotiations between

<sup>6</sup> 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

<sup>7</sup> 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

<sup>8</sup> 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S., 116 S. Ct. 1384 (1996).

buyers and sellers. Thus such a modification would be an obvious expedient within the scope of the art.”

Combining the Tozzoli reference with Fraser, by altering the system of Fraser to include providing the transaction request from the transaction center to a subset of the plurality of responsible parties having a matched profile, would destroy the stated purpose of Fraser: **“qualification of buyers based on information supplied by the buyer; and a means of transmitting information about an interested buyer to a seller”** and see Fraser at Col 3 lines 4-7. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01.

The suggested modification of Fraser proposed by the Examiner would have the system send buyer criteria used during the matching process to sellers after matching has occurred. However, the sellers in Fraser already receive identification numbers of the property in which the buyer is interested. See Col 6 lines 53-58. Not only would providing both the buyer criteria and identification number be redundant, but it would encourage a seller to game the system of Fraser. Sellers in Fraser could hold back on providing a number of property listings, wait until both the buyer criteria and identification number are received for a listed piece of property, and then not provide an offer of a property identified by the identification number but instead use the buyer criteria to make a property offer for a nonlisted piece of property outside of the system. The sellers of Fraser would be encouraged to game the system in the aforementioned matter because sellers in Fraser pay a first fee for listing and a second fee for consummating a sale of a listing. See Col 6 lines 15-22.

Finally, the system described in Fraser is a matching system in which sellers remain anonymous. See Col 10 lines 15-18. Fraser contains no teaching or suggestion that the matching system may be used to negotiate between buyers and sellers. See Abstract, Col 1 lines 7-12., and Col 2 lines 62-65.

Accordingly, Fraser does not teach “providing the transaction request from the transaction center to a subset of the plurality of responsible parties having a matched property

profile” as claimed by the Applicants and Tozzoli does not cure the defect because the combination of Fraser and Tozzoli would destroy the stated purpose of Fraser.

With respect to dependent claims 3-10, 12-14, 17-19, 22-25, 27-28, 31-33, 35-42, and 44-47, which depend on claims 1, 20, or 34, Applicants submit that a dependent claim incorporates each of the claim elements of the claim from which it depends. Applicants respectfully submit that claims 3-10, 12-14, 17-19, 22-25, 27-28, 31-33, 35-42, and 44-47, are allowable over the cited reference for at least the reasons stated above and requests the withdrawal of the § 103 rejection and allowance of the claims.

Claims 14, 19, 29, 33, 41-42 and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli as applied to claim 1, and further in view of Broerman (U.S. 6,594,633).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not teach or suggest<sup>9</sup> all of the claim elements of claims 14, 19, 29, 33, 42 and 46 and the combination with Broerman does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 14, 19, 29, 33, 42 and 46.

Claims 2, 11, 21, 26 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli and Broerman as applied to claim 1, and further in view of Walker et al. (U.S. 5,884,272; hereinafter “Walker”).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not teach or suggest all of the claim elements of claims 2, 11, 21, 26 and 39 and the combination with Broerman and Walker does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 2, 11, 21, 26 and 39.

Claims 15-16, 30 and 43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fraser in view of Tozzoli and Broerman and further in view of Eggleston et al. (U.S. 6,061,660; hereinafter “Eggleston”).

Applicants submit that a dependent claim incorporates each of the claim elements of the independent claim it properly depends from. Applicants assert that Fraser and Tozzoli do not

---

<sup>9</sup> The references when combined must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

teach or suggest all of the claim elements of claims 15-16, 30 and 43 and the combination with Broerman and Eggleston does not cure the defect. Therefore, Applicants respectfully request withdrawal of the § 103(a) rejection and allowance of claims 2, 11, 21, 26 and 39.

**CONCLUSION**


Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney Randy Canis at 636-681-1324 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

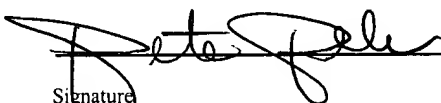
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
636-681-1324

Date 31 March '08

By   
Timothy B. Clise  
Reg. No. 40,957

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31 day of March 2008.

Peter Rebuffoni  
Name

  
Signature